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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/660,073	09/11/2003	Anthony Edward Martinez	AUS920030565US1	6179
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EXAMINER

JONES, ANDREA N

ART UNIT

PAPER NUMBER

2179

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/660,073

Applicant(s)

MARTINEZ ET AL.

Examiner

Andrea N. Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-6, 9-11, 12-19 22- 24, 25 and 26 is/are rejected.
- 7) ☐ Claim(s) 7, 8, 20, 21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>07/27/2006</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Reference character 510, paragraphs 48, 49, and 70. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 25 and 26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

With respect to claims 25 and 26, the “computer readable medium,” in accordance with Applicant’s specification, may be a “wireless communication links using transmission forms such as radio frequency and light wave transmissions”. This subject matter is not limited to that which falls within a statutory category of invention because it is not limited to a process, machine, manufacture, or a composition of matter. Instead, it includes a form of energy. Energy does not fall within a statutory category since it is clearly not a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 10 and 23 rejected under 35 U.S.C. 102(e) as being anticipated by Ball et al. (U.S. PG Pub US 2002/0126135 A1).

As to claim 10, Ball discloses a method in a data processing system for managing messages (paragraph 2, Fig 28), comprising receiving a message from a user (paragraph 260, Fig 28), displaying text in the message (paragraph 260, Fig 28), responsive to a marker being present in the message, displaying the marker in the text (paragraph 261, Fig 28), and responsive to the marker being present in the message, displaying an image associated with the marker (paragraph 261, Fig 28).

As to claim 23, Ball teaches a data processing system for managing messages (paragraph 2, Fig 28) comprising, receiving means for receiving a message from a user (paragraph 260, Fig 28 reference character 740), first displaying means for displaying text in the message (paragraph 260, Fig 28 reference character 720). Additionally Ball teaches a second displaying means, responsive to a marker being present in the message, for displaying the marker in the text (paragraph 261, Fig 28 reference character 740; and third displaying means, responsive to the marker being present in

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the message, for displaying an image associated with the marker (paragraph 261, Fig 28 reference character 748).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 11 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ball et al. (U.S. PG Pub US 2002/0126135 A1) in view of Microsoft Outlook.

As to claim 11, note the discussion above, Ball teaches a method of claim 1. Ball does not teach a storing all messages in a log wherein the log includes text, markers, and images. Microsoft Outlook teaches storing all messages in a log (Figure 1 and Figure 2, "Inbox") wherein the log includes text, markers, and images (Figure 3 and Figure 4). It would have been obvious to one skilled in the art at the time the invention was made to have combined the method of a data processing system for managing messages with the method of Outlook of logging the messages. The motivation for combining the method of Ball with the method of Outlook is to keep a record of the messages for future use and to refer back to when needed without the materials needing to be re-sent.

As to claim 24, Ball teaches a data processing system. Ball does not teach storing means, for storing all messages in a log wherein the log includes text, markers, and images. Microsoft Outlook teaches storing means, for storing all messages in a log

(Figure 1 and Figure 2, "Inbox") wherein the log includes text, markers, and images (Figure 3 and Figure 4). It would have been obvious to one skilled in the art at the time the invention was made to have combined the method of a data processing system for managing messages with the method of Outlook of logging the messages. The motivation for combining the method of Ball with the method of Outlook is to keep a record of the messages for future use and to refer back to when needed without the materials needing to be re-sent.

7. Claims 1-6, 14-19, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ball et al. (U.S. PG Pub US 2002/0126135 A1) in view of Microsoft Windows Paint.

As to claim 1, note the discussion above, Ball teaches a method in a data processing system for managing messages, which comprises placing a marker in a text message wherein the marker is associated with the selected image. Ball does not teach displaying a viewport on a display in association with a chat window, wherein the viewport defines an area on the display responsive to a user input to select an image, defining the image as graphical data in the area defined by the viewport to form a selected image and placing the marker in the chat window. Microsoft Windows Paint teaches displaying a viewport on a display (Fig 1 reference character 100), wherein the viewport defines an area on the display (Fig 2a reference character 200 "selection tool"), responsive to a user input to select an image, and defining the image as

graphical data in the area defined by the viewport to form a selected image (Fig 2b rectangular dotted line).

Figures 3a, 3b, and 4, show the process of placing the selected image by a copy and paste function into a word processing application with similar features as a chat window such as formulating textual messages and functionality of inserting images. It would have been obvious to one skilled in the art at the time of the invention was made to have recognized the similar features of a chat window to any word processing application and correlated the advantages of users communicating directly with one another as discussed by Ball (paragraph 3). The motivation to combine a viewport with a chat window would enhance the quality of text messaging by reducing the time to transfer images by not utilizing attachments to send images, which is discussed by Ball (paragraph 5).

As to claim 2, Ball teaches responsive to a user input to send the text message, sending the text message and the image to a target, wherein the text message and the image are displayed at the target (Fig 28, paragraph 259).

As to claim 3, Ball teaches responsive to a pointer being moved over the marker (Fig 28 reference character 750, paragraph 261) and displaying the image associated with the marker (Fig 28 reference character 752, paragraph 261).

As to claim 4, Ball teaches wherein the marker is an icon or a thumbnail representation of the image (paragraph 257).

As to claim 5, Ball teaches wherein a marker is displayed in a callout window (paragraph 261).



As to claim 6, note the discussion above. Ball teaches a chat window. Ball does not teach a viewport. Microsoft Windows Paint teaches a viewport. It would have been obvious to one skilled in the art at the time the invention was made to attach a viewport to a chat window. The motivation of attaching a viewport to a chat window would eliminate the process of opening another application/window, which would save time.

As to claim 14, Ball teaches a system for managing messages, with placing means for placing a marker in a text message, wherein the marker is associated with the selected image. Ball does not teach displaying means for displaying a viewport on a display, wherein the viewport defines an area on the display, defining means responsive to a user input to select an image, for defining the image as graphical data in the area by the viewport to form a selected image and placing the marker in a chat window. Microsoft Windows Paint teaches displaying means for displaying a viewport on a display (Fig 1 reference character 100), wherein the viewport defines an area on the display (Fig 2a reference character 200 "selection tool"), defining means responsive to a user input to select an image, for defining the image as graphical data in the area by the viewport to form a selected image (Fig 2b rectangular dotted line).

Figures 3a, 3b, and 4, show the process of placing the selected image by a copy and paste function into a word processing application with similar features as a chat window such as formulating textual messages and functionality of inserting images. It would have been obvious to one skilled in the art at the time of the invention was made to have recognized the similar features of a chat window to any word processing application and correlated the advantages of users communicating directly with one

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another as discussed by Ball (paragraph 3). The motivation to combine a viewport with a chat window would enhance the quality of text messaging by reducing the time to transfer images by not utilizing attachments to send images, which is discussed by Ball (paragraph 5).

As to claim 15, Ball teaches sending means, responsive to a user input to send the text message, for sending the text messages and the image to a target, wherein the text message and the image are displayed at the target (Fig 28, paragraph 259).

As to claim 16, Ball teaches wherein the displaying means is a first displaying means, second displaying means, responsive to a pointer being moved over the marker, for displaying the image associated with the marker (Fig 28, paragraph 261).

As to claim 17, Ball teaches wherein the marker is an icon or a thumbnail representation of the image (paragraph 257).

As to claim 18, Ball teaches wherein a marker is displayed in a callout window (paragraph 261).

As to claim 19, note the discussion above. Ball teaches a chat window. Ball does not teach a viewport. Microsoft Windows Paint teaches a viewport. It would have been obvious to one skilled in the art at the time the invention was made to attach a viewport to a chat window. The motivation of attaching a viewport to a chat window would eliminate the process of opening another application/window, which would save time.

As to claim 25, for the prior rejection of non-statutory subject matter, the examiner will be interpreting the claim as per the suggestion of a "computer storage medium" instead of a "computer readable medium". Ball teaches managing messages

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in a chat window and placing a marker in a text message, wherein the marker is associated with the selected image. Ball does not teach a computer program product on a computer storage medium, with first instructions for displaying a viewport on a display, wherein the viewport defines an area on the display, second instructions, responsive to a user input to select an image, for defining the image as graphical data in the area defined by the viewport to form a selected image. Microsoft Windows Paint teaches a computer program product (Paint software) on a computer storage medium (software is stored on a computer), with first instructions for displaying a viewport on a display (Fig 1 reference character 100), wherein the viewport defines an area on the display (Fig 2a reference character 200 "selection tool"), second instructions, responsive to a user input to select an image, for defining the image as graphical data in the area defined by the viewport to form a selected image (Fig 2b rectangular dotted line).

Figures 3a, 3b, and 4, show the process of placing the selected image by a copy and paste function into a word processing application with similar features as a chat window such as formulating textual messages and functionality of inserting images. It would have been obvious to one skilled in the art at the time of the invention was made to have recognized the similar features of a chat window to any word processing application and correlated the advantages of users communicating directly with one another as discussed by Ball (paragraph 3). The motivation to combine a viewport with a chat window would enhance the quality of text messaging by reducing the time to transfer images by not utilizing attachments to send images, which is discussed by Ball

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(paragraph 5). Also to distribute the product in a physical form, which is well known to companies to produce revenue.

As to claim 26, for the prior rejection of non-statutory subject matter, the examiner will be interpreting the claim as per the suggestion of a "computer storage medium" instead of a "computer readable medium". Ball teaches managing messages, receiving a message from a user, displaying text in a message responsive to a marker being present in the message, for displaying the marker in the text, and responsive to the marker being present in the message for displaying an image associated with the marker. Ball does not teach a computer program product on a computer storage medium with instructions. Microsoft Windows Paint teaches a computer program product (Paint software), on a computer readable medium with instructions (software is stored on a computer).

It would have been obvious to one skilled in the art at the time the invention was made to combine managing messages, receiving a message from a user, displaying text in a message responsive to a marker being present in the message, for displaying the marker in the text, and responsive to the marker being present in the message for displaying an image associated with the marker with a computer program product on a computer storage medium with instructions. The motivation to combine would be to distribute the product in a physical form, which is well known to companies to produce revenue.

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8. Claims 12 and 13, are rejected under 35 U.S.C. 103(a) as being unpatentable over Ball et al. (U.S. PG Pub US 2002/0126135 A1) in view of Microsoft Windows Paint, and further in view of McKelvie et al. (U.S. PG Pub US 2003/0217096 A1).

As to claim 12, note the discussion above, Ball in view of Microsoft Windows Paint teaches a data processing system for managing messages and displaying a viewport on a display in association with a chat window in which the viewport defines an area on the display, defines the image as graphical data in the area defined by the viewport to form a selected image in response to a user input to select an image and place a marker in a text message in the chat window in which the marker is associated with the selected image. Ball and Microsoft Windows Paint does not explicitly teach a bus system, a communications unit connected to the bus system, wherein the memory includes a set of instructions and a processing unit connected to the bus system, wherein the processing unit executes the set of instructions. McKelvie teaches a bus system (Fig 14 reference character 147, paragraph 368), a communications unit connected to the bus system (Fig 14 reference character 146, paragraph 369), a memory connected to the bus system, wherein the memory includes a set of instructions (Fig 14 reference characters 142 and 143, paragraph 368), and a processing unit connected to the bus system, wherein the processing unit executes a set of instructions (Fig 14 reference character 141, paragraph 368).

It would have been obvious to one skilled in the art at the time the invention was made to combine a bus system, a communications unit connected to the bus system, wherein the memory includes a set of instructions and a processing unit connected to

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the bus system, wherein the processing unit executes the set of instructions of McKelvie with the data processing system of Ball as modified by Microsoft Windows Paint. The motivation to combine is well known in the art and is a general representation of any processing unit that would require implementation of software. In particular the system taught by McKelvie embodied around the same art of communications (i.e. chat windows and instant messages) as the application.

As to claim 13, note the discussion above, Ball in view of Microsoft Windows Paint teaches a data processing system for managing messages and receiving a message from a user, displaying text in a message, displaying the marker in the text in response to a marker being present in the message, and displaying an image associated with the marker in response to the marker being present in the message. Ball and Microsoft Windows Paint does not explicitly teach a bus system, a communications unit connected to the bus system, wherein the memory includes a set of instructions and a processing unit connected to the bus system, wherein the processing unit executes the set of instructions. McKelvie teaches a bus system (Fig 14 reference character 147, paragraph 368), a communications unit connected to the bus system (Fig 14 reference character 146, paragraph 369), a memory connected to the bus system, wherein the memory includes a set of instructions (Fig 14 reference characters 142 and 143, paragraph 368), and a processing unit connected to the bus system, wherein the processing unit executes a set of instructions (Fig 14 reference character 141, paragraph 368).

It would have been obvious to one skilled in the art at the time the invention was made to combine the bus system, a communications unit connected to the bus system, wherein the memory includes a set of instructions and a processing unit connected to the bus system, wherein the processing unit executes the set of instructions of McKelvie with the data processing system of Ball as modified by Microsoft Windows Paint. The motivation to combine is well known in the art and is a general representation of any processing unit that would require implementation of software. In particular the system taught by McKelvie embodied around the same art of communications (i.e. chat windows and instant messages) as the application.

9. Claims 9 and 22, are rejected under 35 U.S.C. 103(a) as being unpatentable over Ball et al. (U.S. PG Pub US 2002/0126135 A1) in view of Microsoft Windows Paint, and further in view of Microsoft Outlook.

As to claim 9, not the discussion above, Ball as modified by Microsoft Windows Paint teaches the method of a data processing system for managing messages as in claim 1. Ball and modified by Microsoft Windows Paint does not teach wherein messages, markers in the messages, and images are stored in a log allowing for later review of the log with the images being displayed in the proper context with the text. Microsoft Outlook teaches wherein messages, markers in the messages, and images are stored in a log allowing for later review of the log with the images being displayed in the proper context with the text. It would have been obvious to one skilled in the art at the time the invention was made to have combined the teachings of Ball as modified by Microsoft Windows Paint with the logging capabilities of Microsoft Outlook. The

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motivation for combining the method of Ball as modified by Microsoft Windows Paint with the method of Outlook is to keep a record of the messages for future use and to refer back to when needed without the materials needing to be re-sent.

As to claim 22, Ball as modified by Microsoft Windows Paint teaches the method of a data processing system for managing messages as in claim 14. Ball and modified by Microsoft Windows Paint does not teach wherein messages, markers in the messages, and images are stored in a log allowing for later review of the log with the images being displayed in the proper context with the text. Microsoft Outlook teaches wherein messages, markers in the messages, and images are stored in a log allowing for later review of the log with the images being displayed in the proper context with the text. It would have been obvious to one skilled in the art at the time the invention was made to have combined the teachings of Ball as modified by Microsoft Windows Paint with the logging capabilities of Microsoft Outlook. The motivation for combining the method of Ball as modified by Microsoft Windows Paint with the method of Outlook is to keep a record of the messages for future use and to refer back to when needed without the materials needing to be re-sent.

***Allowable Subject Matter***

10. Claims 7, 8, 20, and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The following is an examiner's



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statement of reasons for allowance: The prior art of record does not disclose the limitations of a hot spot, forming an assembly, or logging messages, markers, or images for later review.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ostermann et al. (U.S. Patent No. 6,990,452 B1) discloses a system and method for sending emoticons through instant message, which is a form of a marker in a chat window. Sivan et al. (U.S. Patent No. 6,573,915 B1) teaches a method for capture of computer screens. Bullock et al. (U.S. Patent No. 6,025,827) teaches a viewfinder associated with a capture device window.

### ***Inquiries***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea N. Jones whose telephone number is 571-270-1055. The examiner can normally be reached on Mon - Thurs 7:30 am to 5:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chanh Nguyen can be reached on 571-272-7772. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Andrea N. Jones  
07/24/2006

  
CHANH D. NGUYEN  
SUPERVISORY PATENT EXAMINER